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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,520	11/15/2001	Takahisa Koike	216057US2	7274
22850	7590	04/05/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CHEN, SOPHIA S	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/987,520	KOIKE, TAKAHISA	
Examiner	Art Unit	
Sophia S. Chen	2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 10-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 2,3,6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/01 &amp; 6/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Election***

1. Applicant's election with traverse of Species I, claims 1-9, filed 12/30/04 is acknowledged. The traversal is on the ground(s) that search and examination of the entire application would not place a serious burden on the Examiner.

The Examiner does not agree with the above argument. Even though the claims of the present invention would appear to be part of an overlapping search area, MPEP §808.01(a) states "--- Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it not necessary to show a separate status in the art or separate classification". Also, it would require the Examiner to search in many different classes and subclasses based on four different species (38 claims totally). Therefore, the Examiner strongly believes that it would place a serious burden on the Examiner if the Examiner has to search the entire application.

The requirement is still deemed proper and it therefore made **FINAL**.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The disclosure is objected to because of the following informalities:

- a. Page 32, line 15, "12" should be labeled as "120".
- b. Page 32, line 24, "16" should be "160".

- c. Page 34, line 24, "16" should be "160".
- d. Page 36, line 12, "1601" should be "1602".
- e. Page 38, line 24, "ray" should be "tray".

Appropriate correction is required.

***Claim Rejections – 35 USC §102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta (US Pat. Pub. No. US 2002/0063885 A1).

Dutta discloses an information delivering system comprising: a plurality of copying machines 190 and a managing device 170 for managing the copying machines 190 by the use of a managing database accumulating therein management information on each of the copying machine 190 and outputs delivery information (advertisements) 140 delivered from the managing device 170 from the copying machine 190, wherein the managing device includes a delivery request receiving unit 175 which receives a delivery request for the delivery information 140 from a delivery client terminal 130 operated by an information delivery client (paragraph [0023] and Figure 1); a specifying unit 185 which specifies the copying machines 190 adapted to the delivery request

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received by the delivery request receiving unit 175 based on the management information accumulated in the managing database 240 (paragraph [0025]; Figures 1 and 2); and a delivery information transmitting unit 270 which transmits the delivery information 140 requested to be delivered to the copying machine 190 specified by the specifying unit 185 (Figures 1 and 2).

Dutta further discloses the managing device 170 further comprises a delivery information generating unit 240 which collects the delivery information 140 to be delivered to each of the copying machines 190 specified by the specifying unit 185 per copying machine 190 so as to generate the delivery information 140 for each of the copying machines 190 upon receipt of the delivery request from the plurality of delivery client terminals 130, the delivery information transmitting unit 270 transmitting the delivery information generated by the delivery information generating unit 240 to each of the copying machines 190 specified by the specifying unit 185 (paragraph [0025] and Figure 2); and a delivery information storing unit 225 which stores therein the delivery information 140 for each of the copying machines 190 generated by the delivery information generating unit 240 (Figure 2).

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Claim Rejections – 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta in view of Hobbs (US Pat. Pub. No. US 2002/0080384 A1) and Iwazaki (US Pat. No. 6,705,781 B2).

Dutta, as discussed above, differs from the instant claimed invention in not disclosing the copying machine prints the delivery information at the margin of the printing sheet when a document is copied on the printing sheet in the case where the copying machine receives the delivery information from the managing device.

Hobbs discloses printing advertisement 50 with print job 12 includes, for example, printing advertisement 50 on a page of print job 12 and/or printing advertisement 50 on a separate page of print job 12. Printing advertisement 50 on a page of print job 12 includes, for example, printing advertisement 50 in a corner, at a top or a bottom, and/or on a back of one or more pages of print job 12 (paragraph [0044]).

Iwazaki discloses advertisement data AD being printed on a lower marginal space of a printing medium 23 (page 3, lines 58-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the delivery information (advertisement) being printed at the margin of the printing sheet as taught by both Hobbs and Iwazaki to the copy machine of Dutta so as not to waste the printing medium.

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9. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta in view of Kawai et al. (US Pat. No. 6,404,994 B1).

Dutta, as discussed above, differs from the instant claimed invention in not disclosing the copying machine displays the delivery information on a console panel of the copying machine during a document copying operation in the case where the copying machine receives the delivery information from the managing device.

Kawai et al. discloses a copying machine 10 displays the delivery information on a console panel 18 of the copying machine 11 during a document copying operation (column 12, lines 37-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the delivery information displayed on the console panel of the copying machine as taught by Kawai et al. to the copying machine of Dutta to make it easier for the user to operate and yet provide effectively a more adequate and much larger advertisement effect (Kawai et al., column 12, lines 37-49).

11. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Allowable Subject Matter***

12. Claims 2, 3, 6, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Other Prior Art***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ogawa et al. (US Pat. Pub. No. US 2002/0016972 A1) discloses an information delivery system comprising a plurality of copying machines; a managing device; and ad servers.

Okada et al. (US Pat. Pub. No. US 2002/0054324 A1) discloses an information delivery system comprising a plurality of copying machines; a managing device; and printing fee calculating means.

Ishijima (US Pat. Pub. No. US 2002/0057451 A1) discloses an information delivery system comprising a plurality of copying machines; a managing device; and an advertisement database.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sophia S. Chen whose telephone number is (571) 272-2133. The examiner can normally be reached on M-F (7:00-3:00) First Friday Off.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sophia S. Chen  
Primary Examiner  
Art Unit 2852

Ssc  
April 4, 2005